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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/726,612
Filing Date: December 04, 2003
Appellant(s): CHOSOKABE, AKIYOSHI

Akiyoshi Chosokabe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 22, 2008 appealing from the Office action mailed July 17, 2007.

PRELIMINARY REMARKS

After further consideration, this application contains at least one claim that does not meet the patent eligibility requirement for statutory subject matter under 35 USC 101. Accordingly, this examiner's answer contains a new ground of rejection under 35 U.S.C. 101. Appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR **1.111** with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR **41.39**(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR **41.41**. Such a reply brief must address each new ground of rejection as set forth in 37 CFR **41.37**(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR **41.37**(c). If a reply brief filed pursuant to 37 CFR **41.39**(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR **41.39**(b)(1).

Extensions of time under 37 CFR **1.136**(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR **1.136**(b) for extensions of time to reply for patent applications and 37 CFR **1.550**(c) for extensions of time to reply for ex parte reexamination proceedings.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The brief identifies Konami Corporation and Konami Computer Entertainment as the assignees of rights in the present application as the party of interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

Claims 1-14 are rejected.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

There were no new claims were presented after the final rejection.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed upon appeal is substantially correct. The changes are as follows: Claim(s) 6-14 are rejected under 35 USC 101 as being directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Iwase	US 5,616,079 A1	April 1, 1997
Yamazaki	US 6,280,323 B1	August 28, 2001

(9) Grounds of Rejection

Specification

The amendment filed 2/13/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly amended terminology "composition ratio or ratios" is completely different in scope regarding the previously disclosed "composition rate or rates". The phrase "composition rates" is

interpreted as changes in composition. The phrase "composition ratio" is interpreted as the relation or comparison between compositions. In regards to,

> "the display control section 34 can generate composition (blended) image data of the first pattern image data and the second pattern image data blended according to a positional relationship between the first model and the second model, and image composition rate setting, and display this composite image."

Examiner interprets "the display control section 34 can generate composite (blended) image data of the first pattern image data and the second pattern image data blended according to a positional relationship between the first model and the second model," as defining a ratio between two images or a first pattern image data to a second image data. However by adding "and image composition rate setting, and display this composite image" defines "image composition rate" as something completely different from the positional ratio image e.g. the image composition rate is different from the blended image generated from the positional ratio. Thus, Applicant has failed to provide sufficient evidence that the amended material is supported within the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

The drawings received on 2/13/07 are unacceptable for the reasons as noted above in regards to "composition ratio" e.g. contains new subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly amended terminology "composition ratio or ratios" is completely different in scope regarding the previously disclosed "composition rate or rates". The phrase "composition rates" is interpreted as changes in composition. The phrase "composition ratio" is interpreted as the relation or comparison between compositions. In regards to,

"the display control section 34 can generate composition (blended) image data of the first pattern image data and the second pattern image data blended according to a positional relationship between the first model and the second model, and image composition rate setting, and display this composite image."

Examiner interprets "the display control section 34 can generate composite (blended) image data of the first pattern image data and the second pattern image data blended according to a positional relationship between the first model and the second model," as defining a ratio between two images or a first pattern image data to a second image data. However by adding "and image composition rate setting, and display this composite image" defines "image composition rate" as something completely different from the positional ratio image e.g. the image composition rate is different from the blended image generated from the positional ratio. Thus, Applicant has failed to provide

sufficient evidence that the amended material is supported within the specification and is therefore, interpreted as new matter.

NEW GROUND(S) OF REJECTION

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 6-14 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

(10) Response to Argument

A. Written Description and New Matter Argument

In regards to the case law citations, the rulings are based on a case by case basis. The cases, although relevant, are not final at least based in part on the actual specifics of this particular case.

B. The Claims Are Supported By The Original Specification And The Term "Composition Ratio" Does Not Introduce New Matter Argument

The Examiner respectfully disagrees with the Appellant's assertion that the original specification unequivocally explains the meaning of the "composition ratio" through the below excerpts:

> "[A] result of adding a pixel value P0 corresponding to a pixel having the image composition rate set among the pixel values stored in the display storage section 14, to multiplication pixel value P 1 having composition rate set times image composition rate σ1, that is a value of P0 + P1 x σ1, is set as a new pixel value."

> "In this way, the display control section 34 can generate composite (blended) image data of the first pattern image data and the second pattern image data blended according to a positional relationship between the first model and the second model, and image composition rate setting, and display this composite image."

Appellant discloses that σ1 is more commonly referred to as a "ratio" rather than a "rate", according to which values P0 and P1 are "composed" or "blended", one of ordinary skill in the art would recognize that these terms are closely related in meaning and etymology. Moreover, there could be no confusion to one of ordinary skill in the art regarding what either the term "composition rate" or "composition ratio" refers to, as the above-quoted mathematical expression quite clearly indicates that the value σ1 is the "composition rate" in the described exemplary embodiment. Examiner agrees that in some instances "ratio" and "rates" are closely related in meaning, but that is solely based on the context in which the terms are used and the formulas associated with such terms. However, Examiner respectfully disagrees that the context of the specification and more particularly the mathematical formula clearly defines a "composition ratio".

The mathematical formula defines image composition rate = P0 + P1 x σ1, however, most ratios known in the art is for example A:B, wherein A=3 and B=1. In this example A= 3 x B(1), which is a proportion. However, when referring to the image composition rate = P0 + P1 x σ1, adding P0 to (P1 x σ1) changes the formula from being a ratio formula to some algebraic formula for a term defined as a "composition rate" e.g. the disclosed formula although similar fails to constitute as an actual ratio formula well known in the art.

In regards to:

> "In this way, the display control section 34 can generate composite (blended) image data of the first pattern image data and the second pattern image data

> blended according to a positional relationship between the first model and the second model, and image composition rate setting, and display this composite image."

The composite image data is based on a first pattern image data and the second pattern image data according to a positional relationship between the first model and the second model, and image composition rate setting. This interpreted as two important variables, a positional relationship between the first model and the second model and an image composition rate setting, which indicates that the image composition rate setting in different in scope with comparison to the positional relationship between a first and second model. Even in this regards the positional relationship might signify a positional ratio not an image ratio, but clearly illustrates the image composition rate setting as something different to a positional relationship.

At least in this regards Examiner respectfully submits that appellant fails to satisfy the written description requirement.

C. The Final Office Action of July 17, 2007 and the Advisory Action of October 25, 2007 Misinterpret Appellant's Specification Argument

Appellant respectfully argues that Examiner misinterprets the below passage and for purposes of clarification Examiner explains the following:

In regards to:

> "In this way, the display control section 34 can generate composite (blended) image data of the first pattern image data and the second pattern image data

> blended according to a positional relationship between the first model and the second model, and image composition rate setting, and display this composite image."

The composite image data is based on a first pattern image data and the second pattern image data according to a positional relationship between the first model and the second model, and image composition rate setting. This is interpreted as two important variables, a positional relationship between the first model and the second model and an image composition rate setting, which indicates that the image composition rate setting in different in scope with comparison to the positional relationship between a first and second model. Even in this regards the positional relationship might signify a positional ratio not an image ratio, but clearly illustrates the image composition rate setting as something different to a positional relationship and/or maybe positional ratio. Accordingly at least in this regards the above passage fails to convey to one of ordinary skill in the art an image composition ratio.

D. The Advisory Action of October 25, 2007 Misinterprets Appellant's Arguments

Examiner stated in the Advisory Action of October 25, 2007 that "the applicant attempted to overcome the prior art of record by changing the limitation "rate" to "ratio", making it clear that the terminology changes the invention and/or scope." Appellant argues that the appellant did not rely on this change in traversing any portion of the prior art of record. Examiner respectfully disagrees, due to the following arguments submitted by the Appellant February 13, 2007:

Iwase:

"Regarding the Iwase reference, Iwase appears to show an "image rendering unit that arranges models or polygons of image data stored as texture information, for purposes of texture mapping within a three dimensional space," as alleged by the Examiner; however, the cited portions of Iwase fail to disclose "generating a composite image composed of a plurality of image data based on the image composition **ratios**, and displaying the composite image on the surface of a substantially planar game field," as required by amended claim 1. In other words, the cited portions of Iwase only disclose the rendering of a whole scene, whereas claim 1 requires composing image data, **based on image composition ratios**, to produce a composite image."

"Because Iwase, thus, fails to **anticipate amended claim 1**, Applicant respectfully requests that the Examiner withdraw this rejection of independent claim 1 and its dependent claims 2 and 3. Moreover, because claims 4 and 5 recite features analogous to those of claim 1, Applicant submits that claims 4 and 5 are also patentable over Iwase at least for reasons analogous to those presented above."

When referring to the above, the Appellant clearly states that the amended claims overcome the prior art of record due to the amendments, because the prior art of record fails to incorporate image data based on "image composition ratios".

Yamazaki:

"Although Yamazaki appears to show processing of texture data to be mapped to polygons, and processing of color and luminance data of the textures, Yamazaki does not appear to disclose anywhere that such a texture is a "composite image" which is "composed of a plurality of image data based on... image composition ratios," as required by amended claim 1."

"Thus, Yamazaki also fails to anticipate amended claim 1. Applicant, therefore, respectfully requests that the Examiner withdraw this rejection of independent claim 1 and its dependent claims 2 and 3. Moreover, because claims 4 and 5 recite features analogous to those of claim 1, Applicant submits that claims 4 and 5 are also patentable over Yamazaki at least for reasons analogous to those presented above."

Although the texture image data is a composite image, Appellant clearly states the that Yamazaki fails to discloses a composite image based on at least image composition ratios, which is required by the amended claims.

At least based on the above it is cleared that appellant attempted to overcome the prior art of record by changing the limitation "rate" to "ratio", making it clear that the terminology changes the invention and/or scope.

Conclusion

In conclusion, Examiner respectfully contends that appellant fails to satisfy the written description requirement due to the fact that there is no excerpt clearly defining a

image composition "ratio". Furthermore, Examiner discloses Iwase (US 5,616,079) and Yamazaki (US 6,280,323) as particularly pertinent to the appellant's invention, but was overcome due to the amended claims particularly "composition ratios". It is duly noted, that if appellant intended one of ordinary skill in the art to acknowledge "composition rate" and "composition ratio" to have the same intended meaning the amendment to the specification and claims would not be unnecessary, but by amending and arguing that the prior art of record failed to disclose a "composition ratio" signifies that the intend meaning and/or terminology in context to one of ordinary skill is different than that of a "composition rate".

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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